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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 0837RF-H543-US

In Re Application of:

DANIEL J. SWEIGARD

Serial No.: 10/509,928

Filed: 1 OCTOBER 2004

For: CLIP FOR FIRE DETECTOR WIRE

§
§
§ Examiner: KIMBERLY T. WOOD
§
§ Confirmation No.: 4313
§
§ Art Unit: 3632
§
§

TRANSMITTAL

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Please file the following enclosed documents in the subject application:

1. This Transmittal with Certificate of Mailing;
2. Petition Under 37 CFR § 1.181 From Examiner's Refusal to Enter an Amendment Under 37 CFR 1.111, including Exhibits A-F; and
3. Our return postcard which we would appreciate you date stamping and returning to us.

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8(a)
Date of Deposit: 13 FEB 2007
I hereby certify that this paper or fee is being deposited with the United States Postal Service as First Class Mail with sufficient postage under 37 C.F.R. §1.8(a) on the date indicated above and is addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.
By:

No fees are deemed to be necessary; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayments, to Deposit Account No. **502806**.

Please link this application to Customer No. 38441 so that its status may be checked via the PAIR System.

Respectfully submitted,

13 FEB 2007

Date



James E. Walton, Reg. No. 47,245
Michael Alford, Reg. No. 48,707
Daren C. Davis, Reg. No. 38,425
Brian E. Harris, Reg. No. 48,383
Steven J. Laureanti, Reg. No. 50,274

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CUSTOMER NO. 38441

ATTORNEYS AND AGENTS FOR APPLICANT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In Re Application of:

DANIEL J. SWEIGARD

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Examiner: **KIMBERLY T. WOOD**

Confirmation No.: 4313

Art Unit: 3632

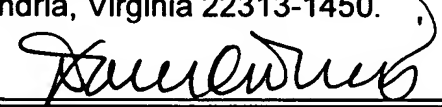
**PETITION UNDER 37 CFR § 1.181 FROM EXAMINER'S REFUSAL TO ENTER AN
AMENDMENT UNDER 37 CFR 1.111**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

1. I, DAREN C. DAVIS, Reg. No. 38,425, am a practitioner of record with Customer No. 38441, having a place of employment at Law Offices of James E. Walton, P.L.L.C., 1169 N. Burleson Blvd., Suite 107-328, Burleson, Texas, 76028.

2. An Office Action having a mailing date of 4 October 2005 indicates that all of the pending claims (*i.e.*, claims 1-4) in the captioned Application are rejected under 35 USC § 103(a) over Applicant's Admitted Prior Art (AAPA) in view of U.S. Patent 5,248,119 to Imura ("Imura"). A copy of the Office Action of 4 October 2005 is provided herewith as **Exhibit A**.

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8(a)
Date of Deposit: 13 FEB 2007
I hereby certify that this paper or fee is being deposited with the United States Postal Service as First Class Mail with sufficient postage under 37 C.F.R. §1.8(a) on the date indicated above and is addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.
By: 

3. An Amendment in response to the 4 October 2005 Office Action was filed on 3 January 2006, within the three-month shortened statutory period for response. In his response, Applicant provides remarks concerning the patentability of rejected claims 1-4 over AAPA in view of Imura. In the Amendment, new claims 5-20 are added and an indication is made that "[n]ew claims 5-20 are allowable over AAPA in view of Imura for at least the same reasons set forth above concerning claims 1-4."¹ A copy of Applicant's Amendment, submitted on 3 January 2006, is provided herewith as **Exhibit B**.

4. An Office Action having a mailing date of 24 March 2006 indicates that Applicant's Amendment in response to the 4 October 2005 Office Action is not fully responsive because "[t]he applicant has not distinctly pointed out how the claims render the new claims patentable over the applied references"², which is taken to mean that, according to Office, Applicant has not distinctly pointed out how the new claims are patentable over the cited references. A copy of the 24 March 2006 Office Action is provided herewith as **Exhibit C**.

5. On 19 April 2006, I spoke with Examiner Kimberly Wood by telephone concerning the 4 October 2005 Office Action, Applicants Amendment of 3 January 2006, and the 24 March 2006 Office Action. It was pointed out to Examiner Wood that Applicant's Amendment in response to the 4 October 2005 Office Action included the statement that the new claims (*i.e.*, claims 5-20) are allowable over the cited references for at least the reasons set forth concerning previously pending claims 1-4. Examiner Wood agreed that the statement indeed complies with the requirement to distinctly point out how the new claims (*i.e.*, claims 5-20) are allowable over the cited references. Examiner Wood further indicated that the 24 March 2006 Office Action would be withdrawn and a new Office Action would be prepared and issued. Moreover, Examiner Wood indicated that no further response was required by Applicant and no Interview Summary was needed.

¹ Applicant's Response, submitted 3 January 2006, to the 4 October 2005 Office Action, p. 16.

² Office Action of 24 March 2006, p. 2, ll. 3-9.

A copy of the telephone bill for my telephone number (*i.e.*, 817-578-8616), redacted to eliminate information not pertinent to this matter and showing a telephone call to Examiner Wood's telephone (*i.e.*, 571-272-6826), as evidence of my telephone call to Examiner Wood, is provided herewith as **Exhibit D**. A copy of an E-mail message from our matter file documenting my telephone conversation with Examiner Wood is provided herewith as **Exhibit E**. A copy of a note indicating that, per a telephone conference with the Examiner, no response is necessary, which was placed in our matter file in the ordinary course of business by James E. Walton of Law Offices of James E. Walton, P.L.L.C. on the face of the 24 March 2006 Office Action on or about the date of my telephone call (*i.e.*, on or about 19 April 2006) to Examiner Wood, is provided herewith as **Exhibit F**.

6. As no new Office Action had been issued by the Office, I spoke again with Examiner Wood on 8 February 2007. Examiner Wood indicated that she has no recollection of our telephone conversation of 19 April 2006. Moreover, Examiner Wood indicated that no notes are included in the Application file concerning our telephone conversation of 19 April 2006. Examiner Wood indicated that no Notice of Abandonment has been issued by the Office in the present Application. Examiner Wood indicated that, absent a filing by Applicant, she could not take up the Application again. Examiner Wood suggested that a Petition be presented by Applicant requesting entry of Applicant's Response of 3 January 2006 and requesting withdrawal of the 34 March 2006 Office Action.

7. Accordingly, Applicant hereby respectfully petitions the Office to (1) enter Applicant's Amendment of 3 January 2006, (2) withdraw the 24 March 2006 Office Action, and (3) prepare and issue a new Office Action in light of Applicant's amendments and remarks provided in Applicant's Amendment of 3 January 2006, as Applicant's Amendment of 3 January 2006 is fully responsive to the 4 October 2005 Office Action.


CONCLUSION

No fees are deemed to be necessary with the filing of the Petition; however, the undersigned hereby authorizes the Commissioner to charge any fees which may be required to Deposit Account No. **502806**.

Should the Office require further information or have any questions, please contact Applicant's representative, Daren C. Davis, at 817-578-8616.

Respectfully submitted,

13 FEB 2007
Date



James E. Walton, Reg. No. 47,245
Michael Alford, Reg. No. 48,707
Daren C. Davis, Reg. No. 38,425
Brian E. Harris, Reg. No. 48,383
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CUSTOMER NO. 38441

ATTORNEYS AND AGENTS FOR APPLICANT

EXHIBIT A



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,928	10/01/2004	Daniel J Sweigard	0837RF-H543-US	4313

38441 7590 10/04/2005

LAW OFFICES OF JAMES E. WALTON, PLLC
1169 N. BURLESON BLVD.
SUITE 107-328
BURLESON, TX 76028

EXAMINER

WOOD, KIMBERLY T

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary

Application No.

10/509,928

Applicant(s)

SWEIGARD, DANIEL J

Examiner

Kimberly T. Wood

Art Unit

3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2004.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-4 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/31/05
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____



Application/Control Number: 10/509,928

Page 2

Art Unit: 3632

This is an office action for serial number 10/509,928.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art figures 1A and 1B in view of Imura 5,248,119. Figures 1A and 1B disclose a clip comprising base portion 13, a clamp portion 11 having opposing fingers 21, 23, and 25 that act as springs and form a channel, and a mounting aperture 17, a base having a lubricant disposed between the base portion and the structure (specification 2, line 1). Figures 1A and 1B disclose all of the limitations of the claimed invention except for the at least two mounting apertures, the polytetrafluoroethylene, and an anti-friction insert member. Imura teaches that it is known to have an anti-friction insert member comprising an elongated shaft portion (near 3), a central channel (where P is received),

Art Unit: 3632

a longitudinal slot (see figure 2A, and column 3, line 10), a flange on each end (where the arrow for 4 is pointing). It would have been obvious to one having ordinary skill in the art to have modified the applicant's admitted prior art figures 1A and 1B to have included the anti-friction insert as taught by Imura for the purpose of to prevent the tubular member from sliding within the clip. It would have been obvious to one having ordinary skill in the art to have modified Figures 1A and 1B to have an additional mounting aperture to the base portions since such a modification is merely a duplication of parts and generally recognized as being within the level of one skilled in the art. It would have been obvious to one having ordinary skill in the art to have modified the Figures 1A and 1B to have made the insert member of polytetrafluoroethylene, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice and the applicant has not disclose how the material is a critical element of the invention. *In re Leshin*, 125 USPQ 416.

Conclusion

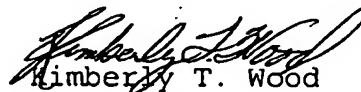
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly

Art Unit: 3632

T. Wood whose telephone number is 571-272-6826. The examiner can normally be reached on Monday-Thursday 7:30am to 5:00pm.

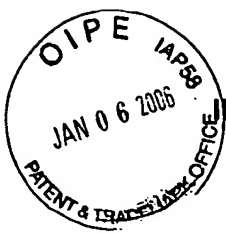
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kimberly T. Wood
Primary Examiner
Art Unit 3632

September 29, 2005

EXHIBIT B



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 0837RF-H5432-US

In Re Application of:

DANIEL J. SWEIGARD

Serial No.: 10/509,928

Filed: 1 OCTOBER 2004

For: CLIP FOR FIRE DETECTOR WIRE

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§ Examiner: KIMBERLY T. WOOD
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§ Confirmation No.: 4313
§
§ Art Unit: 3632
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RESPONSE TO OFFICE ACTION

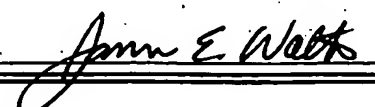
Mail Stop AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is submitted in response to the Office Action dated 4 October 2005, for which the three-month date for response is 4 January 2006.

Amendments to the Claims are reflected in the listing of claims beginning on page 3 of this paper.

Remarks begin on page 9 of this paper.

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8(a)
Date of Deposit: 1/3/06
I hereby certify that this paper or fee is being deposited with the United States Postal Service as First Class Mail with sufficient postage under 37 C.F.R. §1.8(a) on the date indicated above and is addressed to Mail Stop: AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.
By: 

If an extension of time is required to enable this paper to be timely filed and there is no separate Petition for Extension of Time filed herewith, this paper is to be construed as also constituting a Petition for Extension of Time Under 37 CFR § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Enclosed please find our check in the amount of \$200.00 for the one additional independent claim in excess of three independent claims. No other fees are deemed to be necessary; however, the undersigned hereby authorizes the Commissioner to charge any fees which may be required, or credit any overpayments, to **Deposit Account No. 502806**.

Please link this application to Customer No. 38441 so that its status may be checked via the PAIR System.

Reconsideration of the application in view of the following remarks is respectfully requested.

IN THE CLAIMS:

This listing of claims will replace all prior versions and listings of claims in the present application:

Listing of Claims:

Claim 1 (Original): A clip for mounting a fire detector wire to a structure comprising:

a clip member comprising:

a base portion adapted for mounted to the structure;

at least two mounting apertures passing through the base portion; and

a clamp portion upraised from the base portion having opposing spring action finger members;

an anti-friction insert member adapted to carry the fire detector wire comprising:

an elongated shaft portion;

an axial central channel for receiving the fire detector wire;

a longitudinal slot for allowing access to the central channel; and

a flange on ach end of the elongated shaft;

wherein the insert member is configured to be releasably clamped between the finger members, the flanges preventing axial movement of the insert member relative to the finger members.

Claim 2 (Original): The clip according to claim 1, wherein the spring action finger members include opposing curves that define a channel configured to clampingly receive the insert member.

Claim 3 (Original): The clip according to claim 1, wherein the insert member is made of polytetrafluoroethylene.

Claim 4 (Original): The clip according to claim 1, further comprising:
a lubricant disposed between the base portion and the structure.

Claim 5 (New): The clip according to claim 1, wherein the flanges abut the finger members.

Claim 6 (New): The clip according to claim 1, wherein the clip is operably associated with the structure.

Claim 7 (New): The clip according to claim 1, wherein the clip is operably associated with an aircraft.

Claim 8 (New): The clip according to claim 1, wherein the fire detector wire is disposed in the axial central channel.

Claim 9 (New): The clip according to claim 8, wherein the clip is operably associated with the structure.

Claim 10 (New): The clip according to claim 8, wherein the clip is operably associated with an aircraft.

Claim 11 (New): A clip for mounting a fire detector to a structure, the clip comprising:

a clip member defining a channel; and

an anti-friction insert member disposed in the channel and adapted to carry the fire detector wire.

Claim 12 (New): The clip, according to claim 11, wherein the anti-friction insert member comprises:

an elongated shaft; and

a flange on each end of the elongated shaft;

wherein the flanges prevent axial movement of the anti-friction insert member within the channel.

Claim 13 (New): The clip, according to claim 11, wherein the flanges abut the clip member.

Claim 14 (New): The clip, according to claim 11, wherein the clip member comprises:

a base portion adapted for mounting to the structure; and

a clamp portion, upraised from the base portion at an angle of about 155 degrees.

Claim 15 (New): A clip for mounting a fire detector wire to a structure, comprising:

a clip member comprising:

a base portion defining at least two mounting apertures; and

a clamp portion upraised from the base portion at an angle of about 155 degrees, the base portion having opposing spring action finger members; and

an anti-friction insert member comprising polytetrafluoroethylene being releasably disposed in the clamp portion, the anti-friction insert member comprising:

an elongated shaft portion;

an axial central channel for receiving the fire detector wire;

a longitudinal slot extending from an outer surface of the anti-friction insert member to the axial central channel for allowing access to the central channel; and

a flange extending from each end of the elongated shaft, the flanges abutting the finger members.

Claim 16 (New): The clip according to claim 15, wherein the clip is operably associated with the structure.

Claim 17 (New): The clip according to claim 15, wherein the clip is operably associated with an aircraft.

Claim 18 (New): The clip according to claim 15, wherein the fire detector wire is disposed in the axial central channel.

Claim 19 (New): The clip according to claim 18, wherein the clip is operably associated with the structure.

Claim 20 (New): The clip according to claim 18, wherein the clip is operably associated with an aircraft.

REMARKS

I. STATUS OF APPLICATION

Claims 1-20 are currently pending in the present Application. Claims 5-20 have been added and no claims have been canceled. No new matter has been added as a result of the claim amendments.

II. 35 USC § 103 REJECTION

Claims 1-4 stand rejected under 35 USC § 103(a), as being unpatentable over Applicant's Admitted Prior Art ("AAPA") in view of U.S. Patent 5,248,119 to Imura ("Imura"). Applicant respectfully asserts that the claimed invention is patentable over AAPA in view of Imura because (1) neither AAPA nor Imura, whether taken singly or in combination, disclose or suggest the claimed invention and (2) AAPA and Imura are not properly combinable to produce the claimed invention. Each of these aspects in traverse of the § 103(a) rejection of claims 1-4 are discussed below.

A. NEITHER AAPA NOR IMURA DISCLOSE OR SUGGEST THE CLAIMED INVENTION

Independent claim 1, from which claims 2-4 depend, recites "an anti-friction insert member." The Office admits on the record that AAPA fails to disclose the claimed anti-friction insert member but relies upon Imura to teach the anti-friction insert member.¹ Applicant respectfully traverses the Office's allegation that Imura teaches an anti-friction insert member as being contrary to fact.

¹ Office Action of 4 October 2005, p. 2, II. 20-24.

Applicant respectfully asserts that a person having ordinary skill in the art at the time of the invention would appreciate the claimed “anti-friction insert member” to have anti-friction properties. Applicant’s Specification reinforces this fact, as Applicant’s Specification teaches the insert member 129 “is made of, coated with, or treated with an anti-friction material”,² such as “polytetrafluoroethylene”³ or “other suitable anti-friction materials”.⁴ The Office is reminded that, in a recent decision, the U.S. Court of Appeals for the Federal Circuit (CAFC) expressly states:

[t]he Patent and Trademark Office (“PTO”) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art”⁵

(emphasis added). Moreover:

[i]ndeed, the rules of the PTO require that application claims must “conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description”⁶

(emphasis added). The Court further instructs that “[t]he claims are directed to the invention that is described in the specification; they do not have meaning removed from the context from which they arose.”⁷ Moreover, a claim “term can be defined only in a way that comports with the instrument as a whole.”⁸ “A fundamental rule of claim construction is that terms in a patent document are construed with the meaning with which they are

² Specification, p. 2, ll. 27-28.

³ Specification, p. 5, l. 16.

⁴ Specification, p. 5, ll. 16-20.

⁵ *Phillips v. AWH Corp.*, 03-1269, -1286, slip op. at 16 (Fed. Cir. July 12, 2005) (Fed. Cir. BBS), citing *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

⁶ *Phillips*, slip op. at 16, citing 37 CFR § 1.75(d)(1).

⁷ *Phillips*, slip op. at 15, citing *Network, LLC v. Centrall Corp.*, 242 F.3d 1347, 1352 (Fed. Cir. 2001).

presented in the patent document. Thus claims must be construed so as to be consistent with the specification, of which they are a part.⁹ Furthermore:

[u]ltimately, the interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually invented and intended to envelop with the claim. The construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction.¹⁰

Accordingly, based upon the language of rejected, independent claim 1 and Applicant's teaching in his Specification, the claimed "anti-friction insert member" has anti-friction properties. Moreover, the CAFC makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention.¹¹ Accordingly, any element of the prior art that is alleged to be the claimed "anti-friction insert member" must have anti-friction properties.

As noted above, the Office relies upon Imura to teach the claimed anti-friction insert member. However, Imura is silent with regard to its member 4 having any anti-friction characteristics. Rather, Imura teaches that its member 4 "is a resinous or rubber elastic member...being fitted or bonded to the seizing walls (3, 3') or the outer peripheral surface of the pipe (P) as the necessity arises."¹² Applicant respectfully asserts that a person having ordinary skill in the art at the time of the invention would have appreciated that Imura's member 4 frictionally grips the pipe P, rather than having any anti-friction properties, as required by the claimed anti-friction insert member set forth in claim 1. Accordingly, claim 1 and the claims dependent thereto are allowable

⁸ *Phillips*, slip op. at 15, citing *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 389 (1996).

⁹ *Phillips*, slip op. at 15, citing *Merck Co. v. Teva Pharms. USA, Inc.*, 347 F.3d 1367, 1371 (Fed. Cir. 2003).

¹⁰ *Phillips*, slip op. at 15, citing *Renishaw*, 158 F.3d at 1250.

over AAPA in view of Imura because Imura fails to teach the claimed anti-friction insert member and, in fact, cannot suggest the claimed anti-friction insert member because Imura's disclosure teaches away from the claimed anti-friction insert member.

Moreover, independent claim 1, from which claims 2-4 depend, recites "the flanges preventing axial movement of the insert member relative to the finger members." In all of Imura's drawings in which member 4 is depicted,¹³ each of the flanges of member 4 are spaced apart from seizing walls 3, 3'. Thus, the flanges of member 4 cannot prevent axial movement of member 4 relative to seizing walls 3, 3'. Furthermore, Imura is silent with regard to any suggestion that the flanges of member 4 prevent axial movement of member 4 relative to seizing walls 3, 3' or to any suggestion that it would be even desirable for the flanges of member 4 to prevent axial movement of member 4 relative to seizing walls 3, 3'. Accordingly, a person having ordinary skill in the art at the time of the invention would not have appreciated that the flanges of Imura's member 4 could perform the function of preventing axial movement of an insert member relative to finger members, as required by claim 1 and the claims dependent thereto.

For at least these reasons, Applicant respectfully asserts that the 103(a) rejection of claims 1-4 is improper and respectfully requests that the rejection be reconsidered and withdrawn.

¹¹ *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

¹² Imura, col. 3, ll. 9-14.

¹³ See Imura, Figures 1, 2A, and 2B.

B. AAPA AND IMURA ARE NOT PROPERLY COMBINABLE TO PRODUCE THE CLAIMED INVENTION

There can be no motivation or suggestion to combine references as a matter of law where one of the references teaches away from the claimed invention.¹⁴ As discussed above, Applicant respectfully asserts that Imura teaches away from the claimed anti-friction insert member, because Imura's member 4 frictionally grips the pipe P, rather than having any anti-friction properties, as required by the claimed anti-friction insert member set forth in claim 1 and the claims dependent thereto. Accordingly, Imura cannot be combined with AAPA to produce the present invention, as set forth in claim 1 and the claims dependent thereto.

Concerning dependent claim 3, the Office alleges that "[i]t would have been obvious to one having ordinary skill in the art to have modified Figures 1A and 1B to have made the insert member of polytetrafluoroethylene."¹⁵ Firstly, Figures 1A and 1B of the present Application do not illustrate an insert member and the Office has acknowledged this fact on the record. If, instead, the Office intended to allege that it would have been obvious for a person having ordinary skill in the art at the time of the invention to have modified Imura's member 4 to be made of polytetrafluoroethylene, Applicant respectfully traverses this allegation.

Imura specifically teaches that member 4 is "a resinous or rubber elastic member". A person having ordinary skill in the art at the time of the invention would have appreciated that the "resinous or rubber elastic" member 4 would grip pipe P in a frictional interface, with the expectation that pipe P would not move within member 4.

¹⁴ *In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1599 (Fed. Cir. 1988); *In re Gordon*, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984).

Applicant respectfully asserts that a person having ordinary skill in the art at the time of the invention would have appreciated that, generally, members slide readily when in contact with polytetrafluoroethylene and that polytetrafluoroethylene is used in situations wherein frictional contact is undesirable. Accordingly, Applicant respectfully asserts that Imura teaches away from its member 4 comprising polytetrafluoroethylene. Therefore, Imura cannot be combined with AAPA to produce the present invention, as set forth in claim 3.

For at least these reasons, Applicant respectfully asserts that the Office has failed in its burden to establish a *prima facie* case of obviousness. Accordingly, it is respectfully requested that the 103(a) rejection of claims 1-4 be reconsidered and withdrawn.

III. THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20

¹⁵ Office Action of 4 October 2005, p. 3, ll. 13-15.

U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements

regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

IV. NEW CLAIMS

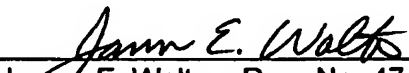
New claims 5-20 are allowable over AAPA in view of Imura for at least the same reasons set forth above concerning claims 1-4.

CONCLUSION

Wherefore, in view of the foregoing remarks, this application is considered to be in condition for allowance, and an early reconsideration and issuance of a Notice of Allowance are earnestly solicited. The Examiner is invited to contact the undersigned at (817) 447-9955 with any questions, comments, or suggestions relating to the referenced patent application.

Respectfully submitted,

1/3/06
Date


James E. Walton, Reg. No. 47,245
Michael Alford, Reg. No. 48,707
Daren C. Davis, Reg. No. 38,425
Brian E. Harris, Reg. No. 48,383

Law Offices of James E. Walton, P.L.L.C.
1169 N. Burleson Blvd., Suite 107-328
Burleson, Texas 76028
(817) 447-9955 (voice)
(817) 447-9954 (facsimile)
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CUSTOMER NO. 38441

ATTORNEYS AND AGENTS FOR APPLICANT

EXHIBIT C



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,928	10/01/2004	Daniel J Sweigard	0837RF-H543-US	4313
38441	7590	03/24/2006	EXAMINER	
LAW OFFICES OF JAMES E. WALTON, PLLC 1169 N. BURLESON BLVD. SUITE 107-328 BURLESON, TX 76028			WOOD, KIMBERLY T	
			ART UNIT	PAPER NUMBER
			3632	

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE

U.S. Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

APPLICATION NO/ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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10/509928

EXAMINER

ART UNIT	PAPER
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20060320

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

see attached

Kimberly T. Wood
Primary Examiner
Art Unit: 3632

This is an office action for serial number 10/509,928.

Response to Amendment

The reply filed on January 6, 2006 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): the applicant has not fully responded to the office action dated October 6, 2005 according to MPEP 714.02 of 37 CFR 1.111 (b). The applicant has not **distinctly pointed out how the claims render the new claims patentable over the applied references**. In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the a examiner's action and must reply to every ground of objection and rejection in the prior Office action. **The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied points out the supposed errors in the references.** If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. See 37 CFR 1.111. Since

Art Unit: 3632

the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment.

EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

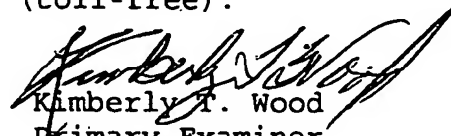
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly T. Wood whose telephone number is 571-272-6826. The examiner can normally be reached on Monday-Thursday 7:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3632

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kimberly F. Wood
Primary Examiner
Art Unit 3632

March 20, 2006

EXHIBIT D



DAREN DAVIS

Page 2 of 3

Account Number [REDACTED]
Billing Date May 21, 2006**Plans and Services****Surcharges and Other Fees - Continued**

1. Texas Universal Service
2. Expanded Local Calling Service

Total Surcharges and Other Fees**Taxes**

3. Federal (Local Charges)
4. Federal (Non-regulated & Toll Charges)
5. State and Local (Local Charges)
6. State and Local (Non-regulated & Toll Charges)

Total Taxes**Total Plans and Services**

Amount Subject to Sales Tax: 110.79

AT&T Long Distance**Important Information**

Message Regarding Terms & Conditions:
To view your Terms & Conditions for AT&T Long
Distance, access www.sbc.com/public_affairs
or call 1-888-225-8530 to have a copy mailed.

Invoice Summary

(as of May 12, 2006)

	Amount
Current Charges	
Service Charges	
Credits and Adjustments	
Call Charges	
Surcharges and Other Fees	
Taxes	

Total Invoice Summary**Service Charges****Monthly Service Charges**

Type of Service	Period	Chg.	Amount
Value Card Plus	05-01-06 to 05-31-06		
Total Monthly Service Charges			
Total Service Charges			

Call Charges - Apr 9th thru May 8th

Calls for 817-578-8616

Call Charges - Apr 9th thru May 8th - Continued

Calls for 817-578-8616 - Continued

Item	No.	Date	Time	Place Called	Number	Code	Min	Amount
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	9.					D	5:00	.00
	10.					D	3:00	.00
	11.					D	2:00	.00
	12.					D	1:00	.00
	13.					D	2:00	.00
	14.	4-19		635A ALEXANDRIA VA	571 272-6826	D	2:00	.00
	15.					D	1:00	.00
	16.					D	1:00	.00
	17.					D	20:00	.00
	18.					D	1:00	.00
	19.					D	6:00	.00
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	25.					D	1:00	.00
	26.					D	1:00	.00
	27.					D	1:00	.00
	28.					D	1:00	.00
	29.					D	23:00	.00
Subtotal Domestic Calls for 817-578-8616								.00

Total Domestic Calls for 817-578-8616**Total Calls for 817-578-8616**

Calls for [REDACTED]

Domestic

Item	No.	Date	Time	Place Called	Number	Code	Min	Amount
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	31.					D	5:00	.00
	32.					D	9:00	.00
	33.					D	27:00	.00
	34.					D	5:00	.00
	35.					D	1:00	.00
	36.					D	2:00	.00
	37.					D	15:00	.00
	38.					D	15:00	.00
	39.					D	2:00	.00
	40.					D	3:00	.00
	41.					D	4:00	.00
	42.					D	17:00	.00
	43.					D	26:00	.00
	44.					D	25:00	.00
	45.					D	7:00	.00
	46.					D	27:00	.00
	47.					D	4:00	.00

EXHIBIT E

Daren C. Davis

From: Daren C. Davis [daren@waltonpllc.com]
Sent: Wednesday, April 19, 2006 7:54 AM
To: 'James E. Walton'
Subject: H-543

Jim:

I just spoke with Examiner Wood concerning the 24 March 06 Office Action. She indicated that the statement in our response, that the new claims are allowable over the cited references for at least the same reasons set forth concerning the previously pending claims, is sufficient. She will withdraw the 24 March Office Action. She indicated that we do not have to file any response or interview summary. If you would like for me to, however, I will be happy to file an interview summary. Just let me know.

Thanks,
Daren

Daren C. Davis | Patent Agent
Law Offices of James E. Walton, P.L.L.C.
(817) 578-8616 (Voice) | (817) 578-8617 (Facsimile) | (817) 360-9267 (Mobile)
Email: daren@waltonpllc.com | Website: www.waltonpllc.com

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240 E. Renfro Street, Suite 104 | Burleson, Texas 76028

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2/12/2007

EXHIBIT F



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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			ART UNIT	PAPER NUMBER
			3632	

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

*Per T/C,
No response
necessary.*

No Postcard due either

